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TM

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/084,787	05/21/98	HARASAWA	S FUJH13.010A

HELFGOTT AND KARAS
EMPIRE STATE BUILDING
60TH FLOOR
NEW YORK NY 10118

PM82/0623

EXAMINER

MOSKOWITZ, N

ART UNIT	PAPER NUMBER
3662	18

DATE MAILED: 06/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	09/08487	Applicant(s)	HARAS SWA
Examiner	N. Moskowitz	Group Art Unit	3662

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 6/7/00

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 15-19 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 15-19 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - All
 - Some*
 - None of the CERTIFIED copies of the priority documents have been
 - received.
 - received in Application No. (Series Code/Serial Number) _____.
 - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

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1. Applicant's letter received June 7, 2000, has been made of record and the amendment received May 5, 2000 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosure of the prior art (Fig. 15 and pages 3-4 of the instant specification) or Aida et al, when taken with Heidemann ('109).

In determining obviousness, the following factual determinations are made:

- a. First, the scope and content of the prior art.
- b. Second, the difference between the prior art and the pending claims.
- c. Third, the level of skill of a person on ordinary skill in this art;
- d. Fourth, whether other objective evidence may be present, which indicates obviousness or nonobviousness. Graham v. John Deere Co., 282 US 1, 17-18, USPQ 456, 466-67 (1966).

Objective evidence includes long felt but unmet need for the claimed invention, failure of others to solve the problem addressed by the claimed invention, and not other factors. See e.g. Simmons Fastener Corp. v. Illinois Tool Works, Inc., 739 Fed. 1573, 1574-76, 22 USPQ 744, 745-47 (Fed. Cir. 1984).

Examining the scope and content of the prior art one finds the following:

- a. Applicant's discussion of the prior art presents an optical amplifier with an input terminal, an optical coupler, a detector, and an optical fiber amplifier. Fig. 15 of Applicant's disclosure is

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identified as prior art and contains similar components. In addition applicant admits that the detector was used to monitor the input signal, and noise problems appeared when the signal level was low. The additional problem of noise, from pump radiation counter-propagating to the signal radiation and then impinging on the detector, is noted.

Therefore the prior art was well aware of the problem of pump radiation noise critically reducing the signal/noise ratio necessary for proper operation of the amplifier.

Aida et al similarly disclose signal input splitting and mounting so as to control pump power (see, *inter alia*, Fig. 1A).

b. Heidemann is directed to fiber optic amplifiers and teaches the use of optical filters positioned downstream and upstream of an optical amplifier to block pump radiation having passed through the amplifier. This pump radiation filtering provides a lower noise level and clearer and cleaner signal radiation data to the detector.

While Heidemann is cited to show the use of filters to remove noise and pass only signals in a optical amplifier system, official notice is taken that optical filtering of optical noise prior to signal detection to improve S/N is very old and well known by artisans in this art technology.

Secondly, under Deere, the difference between this prior art an the pending claims lies in the combination of an optical filter to the post coupler input of Hayata or Applicant's disclosed prior art.

Third, under Deere, the level of ordinary skill in this art may be determined by the analysis of the Court as set forth in Environment Designs Ltd. v. Union Oil Co. 713 F. 3d 693,

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281 USPQ 865-69 (Fed Cir. 19830 cert. denied, 464 1043 (1984)), where the court listed factors relevant to a determination of the level of ordinary skill; type of problems encountered in the art, prior art solutions, rapidity of innovations, sophistication of technology, and educational level of active worker in the field.

The types of problems encountered in the art involve highly complex optics and quantum electronics, and how to provide inexpensive, accurate and reliable, noise reduction.

Innovation in this field has been very fast as can be seen from virtual birth of this field in the 1970s to its present highly complex and sophisticated status.

Prior art solutions include noise filtering. Skilled artisan generally have graduate level education and over seven (7) years of experience, as can be seen from published articles in the major journals in this field, e.g. IEEE Journal of Quantum Electronic, Optical Communications, Optics, etc.

To date, no secondary consideration (objective evidence) has been presented.

Therefore, as this prior art taught both the need and the benefits of such pump radiation filtering, the combination would have been obvious to one skilled in the art.

A further indication of the obvious matter nature of the foresaid combination is the expectancy of the beneficial results from using the optical filter. This follows just as unexpected beneficial results would be evidence of unobviousness Ex parte Novak, 16 USPQ 2d 2041 (Bd. Pat. App, Int. 1990).

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As the aforesaid prior art is known by optical physicists to provide the respective benefits and improvements as set forth above, the physicist would have been led to make the obvious combination of these teachings in order to obtain the benefits this prior art taught and the artisan would typically readily recognize.

Although there is no explicit teaching to combine the aforesaid references, it is noted that an artisan would generally look to optimize optically signaling accuracy while maximizing the S/N. Such optimization ordinarily leads to better signal quality and lowered operation costs.

In response to Applicants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement of obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such as reconstruction is proper. See *In re Fine*, 837 F. 2d 1071 5, USPQ 2d 1596 (Fed. Cir. 1988) and *in re Jones*, 958 F.2d 347, 21 USPQ 2D 1941 (Fed. Cir. 1992). In this case, the reason to combine is the prior art known need for precise signal data and the known problem of pump radiation noise.

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In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Applicant's argument that the combination of Heidemann and the admitted prior art would be inoperative is not cogent. It is immaterial whether or not a physical combination would be operation, as it is the showing of Heidemann using optical filters to pass signals and filter out noise that an artisan would recognize and use in other optical systems.

It is a fundamental fact that using an optical filter positioned before a detector to filter out noise and transmit signals is well known in general, and certainly in the art. Applicant's mere application of the filter for this same purpose provides no novel or unexpected results and is obvious.

Any inquiry concerning this communication should be directed to Examiner Nelson Moskowitz at telephone number (703) 306-4165.

Moskowitz/cw
June 22, 2000



NELSON MOSKOWITZ
PRIMARY EXAMINER